

DETAILED ACTION

Priority

This application is a 371 of PCT/US04/39728 11/26/2004, which claims benefit for domestic priority under 35 U.S.C. § 119(e) [to a provisional application 60/525,430 11/26/2003], is acknowledged.

Status of Claims

Claims 1-29 are currently pending in the application. Claims 30-32 were canceled.

Receipt is acknowledged of amendment / response filed on August 27, 2009 and that has been entered.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 08/27/2009, which has been entered in the file.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group (I), [which includes claims 1-29] drawn to a compound of the formula (I) **without** traverse is acknowledged.

Applicants preserve their right to file a divisional on the non-elected subject matter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual

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or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-29, are rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-29 of co-pending Application No. 11/920,583 (US '583), over claims 1-31 of co-pending Application No. 11/525,291 (US '291) and also claims 30-58 of co-pending Application No. 11/441,537 (US '537). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The compounds taught by co-pending application are similar to instant application because a reference anticipating one set of claim will render the other obvious and it would have been obvious to one of ordinary skill in the art at the time of the invention was made since co-pending applications teach the generic compounds, compositions and their method of uses which are similar to the instantly claimed invention.

The subject matter claimed in the instant application is fully disclosed and covered in the co-pending Application No. US '583, US '291 or in US '537. Therefore, the disclosure of US '583, US '291 or US '537 that teach many permutation and combination substitutions, which would easily place Applicants invention in possession of the public at the time of Applicants invention was filed. The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). Therefore, in the instant case, one skilled in the chemical art would be motivated to choose to replace variable substitutions in permutation and

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combinations in core formula (I) to obtain the desired products in view of the known teaching of the art. The claimed compounds are so closely related structurally to the homologous and /or analogous compounds of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. Moreover, any other differences are but obvious structural modifications, which would be apparent to one skilled in the chemical art that can use similar substitutions, would expect to have the same or essentially the same results. Therefore, in looking at the instantly claimed compounds as a whole, the claimed compounds would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone number for this Group is (571) 273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be

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addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

/Golam M. M. Shameem/

Primary Examiner

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